



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/687,811	07/26/96	ATKINS	BPE-2-064

12M2/0305
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EXAMINER
SHIPFEN, M

ART UNIT
1204

PAPER NUMBER

DATE MAILED: 03/05/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/687,811

Applicant(s)
Martin P. Atkins

Examiner
Michael L. Shippen

Group Art Unit
1204



☒ Responsive to communication(s) filed on Nov 27, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

This action is supplemental to the action of Paper No. 3. The rejections of Paper No. 3 are withdrawn and the following rejections are made. The period for response is restarted from the date of this action.

Claim Rejections - 35 USC § 112¹

Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out the claimed invention. The use of a trademark as a limitation to identify or describe a particular material fails to comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020. A trademark identifies a source of goods, and not the goods themselves. Thus the trademark does not identify or describe the goods associated with the trademark. The claim scope is uncertain since the trademark cannot be used properly to identify any particular material or product.

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102²

Claims 1-3, 12-15, 17-23 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue or JP 5-170698 or JP 5-255185. Note the examples of the references.

Claims 1-4, 12-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Sano (EP 562,139). Note the examples of the references.

Claim Rejections - 35 USC § 103³

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue, JP 5-170698, JP 5-255185 and Sano (EP 562,139) in view of Lazier and Deller. The primary references are applied as above. The primary references teach the claimed process except for some of the claims limitations with respect to the carrier and the addition of ether. The use of a carrier in the analogous process is known as shown by

² The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

³ The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Lazier and Sano. The specific carriers recited are known catalyst carriers as shown by Deller and would be expected to be suitable for the prior art process. It would be obvious to one of ordinary skill in the art that the same advantages of using a carrier would be obtained in the primary reference processes. As to the use of an ether, Inoue suggest in column 7 that other materials such as alkoxy substituted cyclopentanes (cyclohexanes, cycloheptanes and cyclooctanes) and the like may be added to the reaction zone. Such materials are ethers which the claims appear to read upon. The optimization of reaction parameters such as reactant ratios, temperature, pressure and the like to optimize the desired result is well within the skill of the artisan through routine experimentation.

Information Disclosure Statement

The information disclosure statement filed December 21, 1996 fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. As such the Japanese Patent cited has not been considered. Also note the requirements 37 CFR § 1.98(a)(3).

Conclusion

The prior art made of record in Paper No. 3 and not relied upon is considered pertinent to applicant's disclosure.

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Art Unit: 1204

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(703) 308-4635**. The Examiner's normal tour of duty is 8:00 AM to 4:30 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1235**. The Examiner's supervisor, **Gray Geist**, may be reached at **(703) 308-1701**. The official group FAX machine number is **(703) 308-4556**.

MShippen
March 4, 1997

A handwritten signature in cursive script, appearing to read "Michael L. Shippen".

MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1204